

## **II. REMARKS**

Applicants request reconsideration on the merits of the above-referenced patent application.

### **A. Amendments to the Claims**

Claims 1 - 19 are pending. Claims 20 - 29 have been cancelled without prejudice to Applicants' right to file divisional applications directed to the subject matter thereof. Claim 6 has been rewritten in a non product-by-process form support for which can be found in Claim 6 as originally filed and in Example 2 (first three sentences of [0069]). Claim 7 has been rewritten in a non product-by-process form support for which can be found in Claim 7 as originally filed and in Example 9 [0076] and Example 10 (first sentence of [0077]). Claim 15 has been rewritten in a non product-by-process form support for which can be found in Claim 15 as originally filed and in Example 6 ([0073]). Claim 16 has been rewritten in a non product-by-process form support for which can be found in Claim 16 as originally filed and in Example 6 ([0073]) and Example 7 (sentences 1-9 of [0074]).

### **B. Claim Informalities**

As suggested by the Examiner in claim 6 the phrase "the step" has been added after "comprising" and in claims 9 and 18 "or peptide" has been inserted after the second occurrence of "protein".

In light of the cancellation of claim 23 the objection is moot.

### **C. Claim Rejections**

#### *a) Rejections under 35 U.S.C. § 102(b) over Zalipsky*

In point 3 of the Office Action, the Office rejected Claims 6, 8, and 23 for alleged anticipation by Zalipsky (US 5,122,614). The office argues that claim 6 defines the PEG active ester in product-by-process format and is anticipated by the product of Zalipsky.

Applicants have amended Claim 6 to eliminate the product-by-process format and recast in a method of making format. Applicants respectfully

submit that in light of the amendments the rejection of claims 6 and 8 is moot and request that the rejection be withdrawn.

*b) Rejections under 35 U.S.C. § 103(a) over Zalipsky*

In point 4 of the Office Action, the Office rejected Claim 9 for alleged obviousness by Zalipsky (US 5,122,614). The office argues that while Zalipsky doesn't teach the claimed ratio of active ester to protein it would have been obvious to one skilled in the art to routinely vary **all** operable and optimal reaction ratios.

Applicants respectfully submit that the Office has failed to establish a *prima facie* case of obviousness because the claimed ratio is not taught or suggested – merely the fact that **all** ratios could be perceivably be tested is insufficient. It is inadequate to lead one to the forest without providing blaze marks. No blaze marks as to the claimed ratio are provided by Zalipsky.

Applicants respectfully submit the rejection of Claim 9 is moot in light of the amendments to claim 6 as described above and request that the rejection be withdrawn.

*c) Rejections under 35 U.S.C. § 103(a) over Zalipsky and Athwal*

In point 5 of the Office Action, the Office rejected Claims 20-22 and 24-29 for alleged obviousness by Zalipsky (US 5,122,614) and Athwal (US 2002/0151682).

Claims 20, 21, 22, 24, 25, 26, 27, 28, and 29 are canceled without prejudice to Applicants' right to file continuation or divisional applications directed to the subject matter thereof. In view of the cancellation of claims 20, 21, 22, 24, 25, 26, 27, 28, and 29 the rejection is moot.

*d) Rejections under 35 U.S.C. § 102(b) over Greenwald*

In point 6 of the Office Action, the Office rejected Claims 7, 8, and 23 for alleged anticipation by Greenwald (US 6,180,095). The office argues that claim 7 defines the PEG active ester in product-by-process format and is anticipated by the product of Greenwald.

Applicants have amended Claim 7 to eliminate the product-by-process format and recast in a method of making format. Applicants respectfully

submit that in light of the amendment the rejection of Claims 7 and 8 is moot and request that the rejection be withdrawn.

*e) Rejections under 35 U.S.C. § 103(a) over Greenwald*

In point 7 of the Office Action, the Office rejected Claim 9 for alleged obviousness by Greenwald (US 6,180.095). The office argues that while Greenwald doesn't teach the claimed ratio of active ester to protein it would have been obvious to one skilled in the art to routinely vary **all** operable and optimal reaction ratios.

Applicants respectfully submit that the Office has failed to establish a *prima facie* case of obviousness because the claimed ratio is not taught or suggested – merely the fact that **all** ratios could be perceivably be tested is insufficient. It is inadequate to lead one to the forest without providing blaze marks. No blaze marks as to the claimed ratio are provided by Greenwald.

Applicants respectfully submit the rejection of Claim 9 is moot in light of the amendments to Claim 7 as described above and request that the rejection be withdrawn.

*f) Rejections under 35 U.S.C. § 103(a) over Greenwald and Athwal*

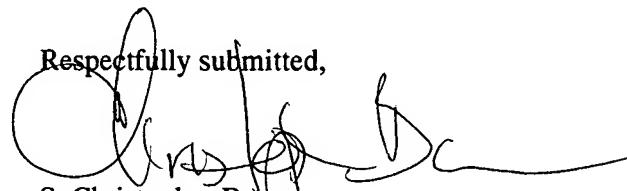
In point 8 of the Office Action, the Office rejected Claims 20-22 and 24-29 for alleged obviousness by Greenwald (US 6,180.095) and Athwal (US 2002/0151682).

Claims 20, 21, 22, 24, 25, 26, 27, 28, and 29 are canceled without prejudice to Applicants' right to file continuation or divisional applications directed to the subject matter thereof. In view of the cancellation of claims 20, 21, 22, 24, 25, 26, 27, 28, and 29 the rejection is moot.

*g) Allowed and Allowable Claims*

Applicant' acknowledge that the Examiner allowed claims 1-5, 11-14, 16, and 19, found claim 10 to be allowable if rewritten in independent form including all of the limitations of the base claims and intervening claims, and found claims 15, 17, and 19 to be allowable if rewritten to overcome the claim objections set forth.

In view of the foregoing amendments, it is respectfully submitted that all claims now active in the present application are in condition for allowance. Therefore, swift passage of the application and claims to issue is respectfully requested.

Respectfully submitted,  
  
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